

CLAIMS 2-12 AND 14-18

Claims 2-12 and 14-18 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-12 and 14-18 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-12 and 14-18 recite additional limitations that independently render them patentable over *Blumberg*.

CLAIM 19

Claim 19 requires the limitation of “generating preview document data at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device.” As set forth herein with respect to Claim 1, there is no mention or suggestion in *Blumberg* that the client or server computers, on which components of the Virtual Builder software might be implemented, contain any printing capabilities. Thus, the client and server computers mentioned in *Blumberg* are not “printing devices” as recited in Claim 1. It is therefore respectfully submitted that Claim 19 includes one or more limitations that are not in any way taught or suggested by *Blumberg* and is therefore patentable over *Blumberg*.

CLAIMS 20-25

Claims 20-25 all depend from Claim 19 and include all of the limitations of Claim 19. It is therefore respectfully submitted that Claims 20-25 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 19.

CLAIMS 26-28

Claims 26-28 recite limitations similar to Claim 1, except in the context of a computer-readable medium, a system and a document preview apparatus. It is therefore respectfully submitted that Claims 26-28 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1.

CLAIMS 29-39 AND 41-45

Claims 29-39 and 41-45 all depend from Claim 26 and include all of the limitations of Claim 26. It is therefore respectfully submitted that Claims 29-39 and 41-45 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 26.

CLAIMS 46-56 AND 58-62

Claims 46-56 and 58-62 all depend from Claim 27 and include all of the limitations of Claim 27. It is therefore respectfully submitted that Claims 46-56 and 58-62 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 27.

CLAIMS 63-69

Claims 63-69 recite limitations similar to Claims 19-25, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 63-69 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claims 19-25.

CLAIMS 70-76

Claims 70-76 recite limitations similar to Claims 19-25, except in the context of apparatuses. It is therefore respectfully submitted that Claims 70-76 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claims 19-25.

In view of the foregoing, it is respectfully submitted that Claims 1-12, 14-39, 41-56 and 58-76 are patentable over *Blumberg*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-12, 14-39, 41-56 and 58-76 under 35 U.S.C. § 102(e) as being anticipated by *Blumberg* is respectfully requested.

REJECTION OF CLAIMS 13, 40 AND 57 UNDER 35 U.S.C. § 103(a)

Claims 13, 40 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando*, U.S. Patent No. 6,449,053. It is respectfully submitted that Claims 13, 40 and 57 are patentable over *Blumberg* and *Bando*, alone or in combination, for at least the reasons provided hereinafter.

Claim 13 depends from Claim 1 and includes all of the limitations of Claim 1. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Blumberg*. For example, as set forth herein with respect to Claim 1, *Blumberg* does not teach or suggested the limitations “generating preview document data

at the printing device based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client.” It is also respectfully submitted that these limitations are not taught or suggested by *Bando*. *Bando* describes a printing system with a RIP server that converts PDL data into raster image data. There is no description in *Bando* of a printing device configured to generate preview document data as required by Claim 13. Accordingly, it is respectfully submitted that Claim 13 includes one or more limitations that are not taught or suggested by *Blumberg* and *Bando*, considered alone or in combination, and is therefore patentable over *Blumberg* and *Bando*.

The Final Office Action asserted that the Applicant’s prior comments regarding Claim 13 are moot because the rejection of Claim 13 is based upon 35 U.S.C. § 103(a) and the Examiner does not rely upon *Bando* to teach the generating limitations described above. The Final Office Action also asserted that one cannot show obviousness by attacking references individually, where the rejections are based upon combinations of references. It is well established that to establish a *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. A discussion of whether the references, taken alone or in combination, teach a particular limitation is therefore proper. In the present situation, the references have been discussed to show that the limitations “generating preview document data at the printing device

based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client” are not taught or suggested by *Blumberg* and *Bando*, considered alone or in combination, and that Claim 13 is therefore patentable over *Blumberg* and *Bando*.

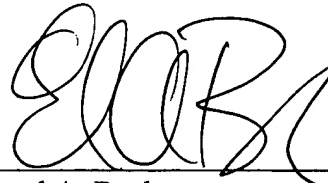
Claims 40 and 57 recite limitations similar to Claim 13, except in the context of a computer-readable medium and an apparatus, respectively. It is therefore respectfully submitted that Claims 40 and 57 are patentable over *Blumberg* and *Bando* for at least the reasons set forth herein with respect to Claim 13. Accordingly, reconsideration and withdrawal of the rejection of Claims 13, 40 and 57 under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando* is respectfully requested.

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER
LLP



Date: November 2, 2004

Edward A. Becker
Reg. No. 37,777

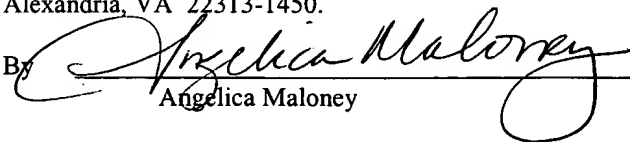
1600 Willow Street
San Jose, CA 95125
(408) 414-1204
Facsimile: (408) 414-1076

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop AF**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On November 2, 2004

By


Angelica Maloney